



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,289	03/27/2001	Hiroshi Hatakama	1095.1179	7696
21171	7590	09/29/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			LANEAU, RONALD	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/817,289

Applicant(s)

HATAKAMA ET AL.

Examiner

Ronald Laneau

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,7,9-12,20,21 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,4,7,9-12,20 and 21 is/are allowed.
- 6) ☒ Claim(s) 26-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3627

***Response to Amendment***

1. The amendment filed on 7/6/06 has been entered. Claims 2 and 25 are canceled, new claims 28 and 29 are added and claims 1, 3, 4, 7, 9-12, 20, 21, 26-29 are now pending.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobin et al. (2001/00291 A1) in view of Ng (6,405,175 B1) and further in view of Walker et al (US 2005/0027601 A1).

As per claims 26-29, Jacobi discloses a product information supply method for supplying a terminal of a user who desires to purchase a product via a network with information about a related product that could be bought together with said product (Figs. 1, 2, 5, 7; Abstract; [0003]), said method steps comprising: receiving combination information about combinations of related products purchased by an individual via a terminal over a network, the combination information including a type of use, a relationship between the related products, and a degree of usefulness (figs. 1-79 Abstract; [0003]-[0019]). Jacobi does not disclose registering the combination information in a database but Ng discloses registering the combination information in a database, forwarding the registered combination to other users via the network by prioritizing the

Art Unit: 3627

registered combination information and the degree of usefulness based on a number of times the registered combination information has been purchased by other user, and based on a number of times reference has been made to a web page including the registered combination information (figs. 1-7; cols. 3-4, lines 23-8, col. 4, lines 57-67, cols. 5-11). Neither Jacobi nor Ng discloses that the product information acquiring method can be used with combination information but Walker discloses allowing a plurality of consumers to each purchase a same combination of products via a network, as that of the combination of products purchased by the individual (page 4, box [0049], lines 24-29, box [0050], lines 1-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the database registering the combination as taught in Ng in the system of Jacobi because it would allow the system to store promotional information based on supply and/or demand for direct access by consumers and create a reward based on consumers' viewing of the web pages. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have utilized combination product information in the product information registering method of Walker into the combined systems of Jacobi and Ng because consumers are often shopping for related products, merchants utilize this information to upsell and cross-sell by decreasing inventories and thereby increasing profitability, and merchants/manufacturers utilize this information to market products to consumers, i.e. bundling, in order to generate increased revenue streams and remain competitive.

***Allowable Subject Matter***

4. Claims 1, 3, 4, 7, 9-12, 20, and 21 are allowed.

None of the references, either singularly or in combination, discloses the totality of the combination in the claims such as:

As per claims 1, 3, 4, 7, and 9-12, a product information supply method comprising: searching the database in response to inquiries about the combination information extracted from the database, wherein each of the inquiries corresponds to a choice signal that indicates a product chosen at a terminal of a consumer in order to specify a candidate for at least one purchase and to place a buy order, and the combination information extracted from the database has been registered by an individual having a similar profile to the profile of the consumer; supplying the terminal of the consumer the combination information which comprises the relationship between the combined products, a type of use, and a degree of usefulness of the combination information; allowing a plurality of consumers to each purchase a same combination of products via a network, as that of the combination of products purchased by the individual; and determining priority of supplying a consumer with the combination information and the degree of usefulness based on a number of times a purchase of the same combination of products have been made based on the combination information, and based on a number of times reference has been made to a web page that introduces the same combination of products described in the combination information as link information.

A product information supply apparatus comprising: information outputting unit for searching the database on the basis of inquiry information about the combination of

Art Unit: 3627

the products from users, wherein each of the inquiries corresponds to a choice signal that indicates a product chosen at a terminal of a consumer in order to specify a candidate for at least one purchase and to place a buy order, and the combination information extracted from the database has been registered by a consumer having a similar profile to the profile of the consumer and sending the extracted corresponding combination information comprising the relationship between the combined products, a type of use, and a degree of usefulness of the combination information to terminals of the users; reward storing unit a value indicating a reward based on a number of time a purchase of a same combination of products has been made by the users or a number of times reference has been made to a Web page that introduces the combination of the products, when is made by another user to the combination information that has been registered by said person or reference is made to the Web page described in the combination information as link information; and priority determining unit for determining priority of supplying a user with the combination information of products and the decree of usefulness based on the number of times a purchase of the same combination of products have been made based on the combination information, and based on the number of times reference has been made to the Web page by the corresponding combination information.

### ***Response to Arguments***

5. Applicant's arguments filed on 7/6/06 have been fully considered but they are not persuasive.

Applicant's arguments about claims 1, 3, 4, 7, 9-12, 20, 21 are moot in view of the new position taken by the Examiner. In response to applicant's argument that there is

Art Unit: 3627

no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3627



Ronald Laneau  
Primary Examiner  
Art Unit 3627

9/21/06

rl